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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2747
Docket No.: 826.1516

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Minoru SEKIGUCHI

Serial No. 09/185,550

Group Art Unit: 2747

Confirmation No. 5524

Filed: November 4, 1998

Examiner: P. Edouard

For: DATA ANALYSIS AND DEVICE OPERATION BASED ON DATA ASSOCIATED WITH WORDS

REQUEST FOR RECONSIDERATION,
WITHDRAWAL OF FINALITY AND EXAMINER INTERVIEW

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

RECEIVED

AUG 18 2004

Attn: Box AF

Technology Center 2600

Sir:

This is in response to the Office Action mailed April 16, 2004, having a period for response set to expire on July 16, 2004. A Petition for a one-month extension of time, together with the requisite fee, is submitted herewith, making the period for response end on August 16, 2004.

In the April 16, 2004 Office Action, the Examiner indicated that claims 1-3 and 13 were pending in the application and were rejected under 35 USC § 103(a) as unpatentable over U.S. Patents 6,396,954 to Kondo; 6,064,959 to Young et al. (References A and D, respectively in the June 9, 2003 Office Action) and 5,870,701 to Wachtel (Reference A in the April 16, 2004 Office Action). However, claim 15 was added by the Amendment filed by Certificate of Mail on September 9, 2003 and received by the U.S. Patent and Trademark Office on September 11, 2003. Attached hereto is a copy of the September 9, 2003 Amendment which indicates that claim 15 was listed as added on pages 2 and 5 and appears on page 4. Thus, as noted on

pages 5 and 7 of the September 9, 2003 Amendment, claims 1-3, 13 and 15 remain in the case. The Examiner's rejections are traversed below.

Withdrawal of Finality and Request for Examiner Interview

Since claim 15 was not examined in the April 16, 2004 Office Action, it is respectfully requested that the Examiner withdraw the finality of the April 16, 2004 Office Action and reconsider the claims in light of the remarks in the following section.

If the claims continue to be rejected over the combination of Kondo, Young et al. and Wachtel, the Examiner is respectfully requested to contact the undersigned by telephone prior to issuing another Office Action for the purpose of arranging an Examiner Interview to discuss how the claims are being interpreted and what changes to the claims would more clearly distinguish over the prior art.

Rejections under 35 USC § 103

In item 4 on pages 2-4 of the Office Action, claims 1-3 and 13 were rejected under 35 USC § 103(a) as unpatentable over Kondo in view of Young et al. and Wachtel. In addition to the removal of the reference to cancelled claim 4 in the second full paragraph on page 4, only the paragraph spanning pages 3 and 4, and the first full paragraph on page 4, of the April 16, 2004 Office Action differed from the June 9, 2003 Office Action. By adding Wachtel to the references used to reject the claims, the prior art includes natural language processing capability using "a lexicon of all words which may be processed upon input via the keyboard" (column 4, lines 44-45), where the lexicon is separated into grammatical categories as indicated at column 4, line 52 to column 7, line 40.

However, nothing has been found in Wachtel that overcomes the deficiencies of Kondo and Young et al. identified in the September 9, 2003 Amendment. The only source of input from any of the three references cited in rejecting the claims is words from a user, either spoken into a microphone or input using a keyboard. On the other hand, claim 1 recites "data groups in a database in which a natural language word represent ... a characteristic of a corresponding data group ... obtained by classifying inputs from ... [a] sensor" (claim 1, lines 3-5) and slightly different wording is used in claims 13 and 15. Claim 15 was added to specifically recite that "non-language data [is] obtained from at least one sensor" (claim 15, lines 1-2). Since claim 15 was not discussed in the April 16, 2004 Office Action, it is unclear whether this limitation is being given no weight, because it is in the preamble, or whether claim 15 was not examined. With respect to limitations in the preamble of a claim, the Examiner's attention is directed to the

numerous cases that have held such limitations should be given weight where they define terms used in the claims, such as the words "data" and "sensor" in the case of claim 15. For example, see *In Re Fritch*, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992); *Perkin Elmer Corp. v. Computer-vision Corp.*, 221 USPQ 669, 675 (Fed. Cir. 1984); *Kropa v. Robie*, 88 USPQ 478, 480 (CCPA 1951); and cases cited in these cases.

As discussed above, if all of the claims will not be allowed as a result of this Request for Reconsideration, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview to discuss what changes, if any, must be made to the claims to clearly distinguish over the combination of Kondo, Young et al. and Wachtel.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-3, 13 and 15 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this Request, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 8/16/04

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